

REMARKS

The Office Action mailed August 29, 2003 has been reviewed and carefully considered. Before entry of the present amendment, Claims 1-8 and 10-23 were pending, with Claims 1, 6, and 10 being in independent form. In the present amendment, no pending claims have been amended, and Claim 24 has been added. After entry of the present amendment, Claims 1-8 and 10-24 will be pending, with Claims 1, 6, 10, and 24 being in independent form. Reconsideration and withdrawal of the rejections in the August 29, 2003 Office Action are requested on the basis of the following remarks.

In the Office Action dated August 29, 2003, the following grounds of rejection were raised:

- I. Claims 1, 6, 10, and 15-17 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite (Office Action, ¶4-6);
- II. Claims 1, 5, 6, 8, 16, 17, 18, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT (Lambert, P., "FCC puts satellite DAB plan up for comment," *Broadcasting*, Vol. 122, no. 143 (October 19, 1992), p. 28, hereinafter LAMBERT) in view of ROTHBLATT (Rothblatt, M., "Talking stars and talking cars," *Satellite Communications*, Vol. 14, no. 6 (June 1990), p. 12, hereinafter ROTHBLATT) and further in view of *Foladare et al.* (U.S. Patent 5,819,160, hereinafter *Foladare*) (Office Action, ¶8); and, in the alternative, over (B) LAMBERT in view of ROTHBLATT, *Rakavy* (U.S. Patent 5,913,040, hereinafter *Rakavy*), EXCITE@HOME ("Excite@Home Goes Direct to Consumers With online Sign-Up for High-Speed Broadband Internet Service," PR Newswire (September 22, 1999), hereinafter EXCITE@HOME) *Foladare*, and *Eller et al.* (U.S. Patent 5,889,860, hereinafter *Eller*) (Office Action, ¶16);
- III. Claims 10-15 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT in view of ROTHBLATT, *Foladare*, and *Eller* (Office Action, ¶9); and, in the alternative, over (B) LAMBERT in view of ROTHBLATT, *Rakavy*, EXCITE@HOME, *Foladare*, and *Eller* (Office Action, ¶16);

- IV. Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladare*, and COMLINE ("Sanyo develops Cell Phone with Music Download and Playback Function," Comline Telecommunications (August 25, 1999), hereinafter COMLINE) (Office Action, ¶10); and, in the alternative, over (B) LAMBERT, ROTHBLATT, *Rakavy*, EXCITE@HOME, *Foladare*, *Eller*, and COMLINE (Office Action, ¶17);
- V. Claims 4 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladare*, *Eller*, and *Barber* (U.S. Patent 6,349,288, hereinafter *Barber*) (Office Action, ¶11); and, in the alternative, over (B) LAMBERT, ROTHBLATT, *Rakavy*, EXCITE@HOME, *Foladare*, *Eller*, and *Barber* (Office Action, ¶21);
- VI. Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladare*, and *Yuhn* (U.S. Patent 6,052,440, hereinafter *Yuhn*) (Office Action, ¶12); and, in the alternative, over (B) LAMBERT, ROTHBLATT, *Rakavy*, EXCITE@HOME, *Eller*, and *Yuhn* (Office Action, ¶18);
- VII. Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladare*, *Yuhn*, and MOTOROLA ("Motorola Investment in Digianswer Boosts Bluetooth and HomeRF Portfolio," Business Wire (October 26, 1999), hereinafter MOTOROLA) (Office Action, ¶13); and, in the alternative, over (B) LAMBERT, ROTHBLATT, *Rakavy*, EXCITE@HOME, *Foladare*, *Eller*, *Yuhn*, and MOTOROLA (Office Action, ¶19);
- VIII. Claim 22 was rejected under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladare*, *Yuhn*, and *Sachs et al.* (U.S. Patent 5,956,034, hereinafter *Sachs*) (Office Action, ¶14); and, in the alternative, over (B) LAMBERT, ROTHBLATT, *Rakavy*, *Foladare*, *Eller*, *Yuhn* and *Sachs* (Office Action, ¶20); and
- IX. Claim 23 was rejected under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladare*, and ADWEEK ("Blockbuster Launches Corporate Campaign," AdWeek Midwest Edition (June 12, 1995), hereinafter ADWEEK) (Office Action, ¶15); and, in the alternative, over (B) LAMBERT, ROTHBLATT, *Rakavy*, EXCITE@HOME, *Foladare*, *Eller*, and ADWEEK (Office Action, ¶22).

I. Rejection of Claims 1, 6, 10, and 15-17
under §112, second paragraph, for indefiniteness

The Examiner rejected all of the independent claims, i.e., Claims 1, 6, and 10, as well as dependent Claims 15-17, under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (Office Action, ¶4-6). First, the Examiner alleged that the language of "wherein the user-specific information comprises ... other information related to the user" as recited in dependent Claims 15-17 renders the scope of those claims indefinite (Office Action, ¶5). Second, the Examiner alleged that, based on statements made in the previous Amendment, independent Claims 1, 6, and 10 "fail to particularly point out and distinctly claim Applicant's invention" (Office Action, ¶6).

The Examiner has failed to make a *prima facie* case for indefiniteness in either of his §112, second paragraph, rejections. As stated in the MPEP, "[i]f upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action" (MPEP §2173.02). The Examiner has provided no analysis for either rejection. In his §112, second paragraph, rejection of dependent Claims 15-17, the Examiner merely states that the "language renders the scope of the claim indefinite because it fails to inform one skilled in the art the [*sic*] what type of user specific information the claim is directed to" (Office Action, ¶5). This is not an analysis, but rather a conclusory statement.

In the §112, second paragraph, rejection of independent Claims 1, 6, and 10, the Examiner merely makes the following syllogism:

Regarding claims 1, 6 and 10, Applicant states the connection between the subscription server and the cellular telephone network is indeterminate. See Paper No. 7, p. 14 (see also *infra*). Applicants also state [*sic*] that there *may* be no less that [*sic*] three different connection means recited by claims 1, 6, 10. Therefore, claims 1, 6, 10 fail to particularly point out and distinctly claim Applicant's invention.

The first two sentences in this syllogism are true. However, the conclusion in the last sentence does not follow from them. In the previous Amendment, it is stated that the means by which the subscription server communicates with the mobile terminal over the cellular telephone network is

"indeterminate, e.g., the subscription server may communicate over the Internet to a gateway server connected to the cellular telephone network, or the subscription server may have a direct connection with the cellular telephone network, or there may be several intermediate links between the subscription server and the mobile terminal" (May 5, 2003 Amendment, page 14). This statement does not render independent Claims 1, 6, and 10 impermissibly vague or indefinite. In fact, this statement from the previous Amendment merely indicates the appropriate breadth of independent Claims 1, 6, and 10. The Examiner has provided no explanation for how or why this statement from the previous Amendment has suddenly rendered independent Claims 1, 6, and 10 indefinite.¹

Furthermore, under any correct analysis or claim construction, none of Claims 1, 6, 10, and 15-17 can be considered indefinite under §112, second paragraph. In a 2002 decision (*All Dental Prodx, LLC v. Advantage Dental Products, Inc.*), the Federal Circuit made the following comments concerning the definiteness requirement under §112, second paragraph:

We also agree with Advantage that its claims comply with the definiteness requirement of section 112, second paragraph. That section states: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. *Warner-Jenkinson*, 520 U.S. at 28-29. That determination requires a construction of the claims according to the familiar canons of claim construction. Only after a thorough attempt to understand the meaning of a claim has failed to resolve material ambiguities can one conclude that the claim is invalid for indefiniteness. Foremost among the tools of claim construction is of course the claim language itself, but other portions of the intrinsic evidence are clearly relevant, including the patent specification and prosecution history. *See Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452, 227 USPQ 293, 296 (Fed. Cir. 1985) ("The specification is, thus, the primary basis for construing the claims. . . . [T]he prosecution history (or file wrapper) limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance."). The prosecution history can thus be relied upon to clarify the claim meaning and hence provide definiteness. *Tex. Instruments Inc. v. Int'l Trade Comm'n*, 871 F.2d 1054, 1063, 10 USPQ2d 1257, 1263-64 (Fed. Cir. 1989) ("The public is entitled to know the scope of the claims but must look to both the patent specification and the prosecution history, especially when there is

¹ It is assumed that the Examiner is not arguing that the mere use of the word "indeterminate" in the Remarks section of an Amendment can render the independent claims indefinite. It is also assumed that the Examiner is not arguing that the mere listing of three different possible embodiments of a claimed invention in the Remarks section of an Amendment can render the independent claims indefinite.

doubt concerning the scope of the claims." (citing McGill Inc. v. John Zink Co., 736 F.2d 666, 221 USPQ 944 (Fed. Cir. 1984))).

When one applies these guidelines to the present case, it is clear that any of Claims 1, 6, 10, or 15-17 satisfy the definiteness requirements of §112, second paragraph. First, the phrase "wherein the user-specific information comprises at least one of the capabilities of said mobile terminal, the preferences of the user, and other information related to the user" fulfills the primary purpose of the definiteness requirement, i.e., ensuring that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe the patent. If one did have any confusion as to the scope of "user-specific information", one could turn to the patent specification, where a description is provided on pages 8-9:

A user is registered when the user submits to the subscription server 20 the requisite user-specific information, which will be stored in a subscription database accessible by the subscription server. The user-specific information includes the capabilities of the user's hardware, the user's financial information, and the user's preferences. Information on the user's hardware capabilities (e.g., user agent, terminal type, network type etc.) enables the server to download data in a format compatible with the mobile terminal's protocol and the user network's protocol. The user's financial information such as, for example, the user's name, address, bank, credit or debit card account and other requisite billing information is included so that fees can be charged against the user's account as appropriate. As one example, the user's preferences are included so that the subscription server 20 can automatically seek out and retrieve digitally-formatted products preferred or otherwise interested by the user (e.g., works of favorite writers, composers, singers, artists, music bands, orchestras, etc.) locally or from other vendor servers connected to the Internet for transmission to the user's mobile terminal using, for example, a search engine.

(present application, line 10, page 8, to line 2, page 9)

Second, there is no phrase or term in any of independent Claims 1, 6, or 10, which lacks the requisite definiteness. If the Examiner believes there is a phrase or term in any of Claims 1, 6, or 10 which is indefinite under §112, second paragraph, the Examiner is respectfully requested to indicate the indefinite phrase or term, and provide an analysis as to why the offending phrase or term is indefinite in light of the claims, the specification, and the prosecution history.

At least because (1) the Examiner has not made a *prima facie* case of indefiniteness under §112, second paragraph; and (2) each of Claims 1, 6, 10, and 15-17 are sufficiently definite under §112, second paragraph, the withdrawal of the §112, second paragraph, rejections are respectfully requested.

II. Rejection of Claims 1, 5, 6, 8, 16, 17, 18, and 20 under §103 as obvious over either (A) LAMBERT, ROTHBLATT, and *Foladere* or (B) LAMBERT, ROTHBLATT, *Foladare*, *Rakavy*, EXCITE@HOME, and *Eller*

The Examiner rejected independent Claims 1 and 6, as well as Claims 5, 8, 16, 17, 18, and 20 dependent thereon, under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT in view of ROTHBLATT and *Foladere* (Office Action, ¶8); or, in the alternative, over (B) LAMBERT in view of ROTHBLATT, *Foladare*, *Rakavy*, EXCITE@HOME, and *Eller* (Office Action, ¶16).

It is difficult to interpret these "alternative" rejections, since the combination of references in alternative §103 rejection (B) includes all the references used in alternative §103 rejection (A). One is tempted to suggest that the very use of alternative §103 rejection (B) in the Office Action indicates that the combination in alternative §103 rejection (A) does not, and can not, teach or suggest all the limitations recited in independent Claims 1 and 6.

Regardless of the reasoning for having alternative §103 rejections (A) and (B), neither of alternative §103 rejections (A) or (B) is proper. Moreover, both of the alternative §103 rejections are improper for almost identical reasons as the previous §103 rejections in the December 4, 2002 Final Office Action were improper. Because of this, the previous Amendment, which responded to the previous §103 rejections, may be referred to for a detailed analysis of the improprieties of the present §103 rejections.

In general, the §103 rejections in the present Office Action are invalid because the Examiner does not adequately specify how the prior art suggests the motivation of the invention claimed in the present application. In fact, the Examiner appears to be engaged in impermissible "hindsight reconstruction", where individual elements from disparate pieces of the prior art are combined in order to create the invention claimed in the present invention. As stated by the Federal Circuit in *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. [The cited references] fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the board.

Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In short, the references cited by the Examiner "fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner". Curiously, the Examiner does not seem to seek any motivation within the references themselves, but instead provides *ad hoc* reasoning that appears to come from the invention claimed in the present application. For example, the 'motivation' for combining LAMBERT and ROTHBLATT is not suggested by either LAMBERT or ROTHBLATT, but instead suggested because "[t]his combination would enable user's [sic] to implement Lambert's pay-per-listen function through the operation of a cell phone" (Office Action, ¶8, page 4, and repeated at ¶16, page 23). However, the desirability of having offers for purchasing digitally formatted products sent to a mobile terminal of a user, after that user has subscribed for such a service on the Internet, is only suggested by the invention claimed in the present application. This type of bootstrap reasoning (i.e., where the combination of elements recited in the claimed invention supplies the suggestion to combine the prior art references) is used throughout the Office Action.

As can be seen in the above example, another problem with the §103 obviousness rejections is the complete lack of specificity in terms of indicating how the combination of prior art references teaches the limitations of the present claims. As stated by the Federal Circuit, "[t]he need for specificity" is essential when explaining how a prior art combination teaches all the components in a claim rejected under §103 (*In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002)). Furthermore, the Examiner must "not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the [PTO]'s conclusion' (*Id.*, at 1344) and those findings "must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability." (*Id.*, at 1344-1345). In the instant case, similarly to the *In re Lee* case, the

Examiner is not providing adequate specificity in his rejections. As stated by the Federal Circuit, "**particular** findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (emphasis added, *In re Kotzab*, 217 F.3d 1365, 1371, (Fed. Cir. 2000)). Furthermore, the Examiner "must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." (emphasis added, *In re Rouffet*, 149 F.3d 1350, 1359, (Fed. Cir. 1998)). Insofar as the Examiner's reasoning for combining the cited prior art references is unclear, the Examiner has not made a *prima facie* case of obviousness.

Returning to the impermissible hindsight reconstruction being used by the Examiner, consider the Examiner's *modus operandi* in the past three Office Actions. In essence, every time the applicant has pointed out a claim limitation not taught by the Examiner's cited combination of prior art references, the Examiner has merely found another prior art reference which the Examiner believes teaches that specific claim limitation. Thus, the list of cited prior art references becomes longer in each subsequent Office Action, but the motivation for combining them becomes more and more tenuous. In each of the previous Amendments, applicant has pointed out that the Examiner has not provided a clear motivation for combining the cited references. Examiner has never responded to applicant's explicit traversal, in regards to the lack of a motivation to combine, of the Examiner's §103 rejections.²

Of course, the steadily increasing number of references used by the Examiner in his §103 rejections is not proof, in and of itself, of hindsight reconstruction. However, it is indicative of a piece by piece, element by element, reconstruction of the claimed invention, especially when considered in combination with the lack of any motivation within the references themselves to combine the references. The mere fact that the Examiner might be able to find each element of the claimed invention by combining a list of prior art references does not prove obviousness under §103. It is not correct for the Examiner merely to focus on the differences between the prior art and the claimed invention, and then to state that the differences themselves or individually are obvious.

² This is in spite of MPEP §707.07(f), which states that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it".

The claimed invention as a whole is to be considered (see, e.g., *Lear Siegler, Inc. v. Aeroquip Corp.*, 221 USPQ 1025, 1033 (Fed. Cir. 1984): "..., the actual determination of [obviousness] requires an evaluation in the light of the findings in those inquiries of the obviousness *of the claimed invention as a whole*, not merely the differences between the claimed invention and the prior art", emphasis added).

Independent Claim 1 of the present application recites a method in which a user of a mobile terminal initially subscribes to an online subscription service by interacting with a subscription server on the Internet. Having subscribed to the service, the user then receives, without any action on his or her part, an offer to download a digitally formatted product. This offer is transmitted to the user's mobile terminal via a cellular telephone network. The user may then respond, via the cellular telephone network, indicating whether the user wishes to accept the offer. If the user accepts the offer, the digitally formatted product is transmitted to the user's mobile terminal via the wireless communication network.

Neither the (A) combination of LAMBERT, ROTHBLATT, and *Foladere* nor the (B) combination of LAMBERT, ROTHBLATT, *Foladare*, *Rakavy*, EXCITE@HOME, and *Eller* teach or suggest **both** the step of "subscribing, by the user, to the on-line subscription service by interacting with a subscription server on the Internet", **and** the step of "transmitting to the mobile terminal via the cellular telephone network at predetermined time intervals and without user action an offer to download a digitally formatted product". At least because independent Claim 1 of the present invention recites these limitations, and the cited prior art neither teaches nor suggests them, independent Claim 1 is patentable over the cited prior art.

In summary, at least because:

- The Examiner has not made a *prima facie* case of obviousness, because he has not provided an adequate motivation or suggestion for making either the (A) combination of LAMBERT, ROTHBLATT, and *Foladere* nor the (B) combination of LAMBERT, ROTHBLATT, *Foladare*, *Rakavy*, EXCITE@HOME, and *Eller* in a §103 obviousness rejection,
- Neither the impermissible (A) combination of LAMBERT, ROTHBLATT, and *Foladere* nor the impermissible (B) combination of LAMBERT, ROTHBLATT, *Foladare*, *Rakavy*, EXCITE@HOME, and *Eller* teach or suggest **both** the step of "subscribing, by the user, to

the on-line subscription service by interacting with a subscription server on the Internet",
and the step of "transmitting to the mobile terminal via the cellular telephone network at predetermined time intervals and without user action an offer to download a digitally formatted product",

-- the rejection of Claim 1 fails. Withdrawal of the rejection of Claim 1 is respectfully requested.

Insofar as the above arguments concerning method Claim 1 are applicable to independent system Claim 6, the rejection of Claim 6 also fails. Withdrawal of the rejection of Claim 6 is respectfully requested.

At least because dependent Claims 5, 8, 16, 17, 18, and 20 depend upon Claims 1 and 6, which are patentable over the cited prior art, Claims 5, 8, 16, 17, 18, and 20 are also patentable over the cited prior art. Withdrawal of the rejection of Claims 5, 8, 16, 17, 18, and 20 is respectfully requested.

However, additional arguments for particular dependent claims can be made. For example, the limitations recited in Claims 16 and 17 are not taught by either combination of prior art cited by the Examiner (see pages 25-26 of the May 5, 2003 Amendment for specifics), and the limitations recited in Claim 18 are not taught by either combination of prior art cited by the Examiner (see page 27 of the May 5, 2003 Amendment for specifics).

III. Rejection of Claims 10-15 and 21 under §103 as obvious over either

(A) LAMBERT, ROTHBLATT, *Foladere*, and *Eller* or

(B) LAMBERT, ROTHBLATT, *Foladere*, *Eller*, *Rakavy*, and *EXCITE@HOME*

The Examiner rejected independent Claim 10, as well as Claims 11-15 and 21 dependent thereon, under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladere*, and *Eller* (Office Action, ¶9); or, in the alternative, over (B) LAMBERT, ROTHBLATT, *Foladere*, *Eller*, *Rakavy*, and *EXCITE@HOME* (Office Action, ¶16).

Insofar as the arguments concerning Claim 1 in Sect. II above are applicable to independent Claim 10, the rejection of Claim 10 also fails. Withdrawal of the rejection of Claim 10 is respectfully requested. At least because dependent Claims 11-15 and 21 depend upon Claim 10,

which is patentable over the cited prior art, Claims 11-15 and 21 are also patentable over the cited prior art. Withdrawal of the rejection of Claims 11-15 and 21 is respectfully requested.

IV. Rejection of Claim 19 under §103 as obvious over either

(A) LAMBERT, ROTHBLATT, *Foladere*, and COMLINE or

(B) LAMBERT, ROTHBLATT, *Foladere*, COMLINE, *Rakavy*, EXCITE@HOME, AND *Eller*

The Examiner rejected dependent Claim 19 under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladere*, and COMLINE (Office Action, ¶10); or, in the alternative, over (B) LAMBERT, ROTHBLATT, *Foladere*, COMLINE, *Eller*, *Rakavy*, and EXCITE@HOME (Office Action, ¶17). At least because Claim 19 depends from independent Claim 1, which is patentable over the cited prior art, Claim 19 is also patentable over the cited prior art. Withdrawal of the rejection is respectfully requested.

V. Rejection of Claims 4 and 7 under §103 as obvious over either

(A) LAMBERT, ROTHBLATT, *Foladere*, *Eller*, and *Barber* or

(B) LAMBERT, ROTHBLATT, *Foladere*, *Eller*, *Barber*, *Rakavy*, and EXCITE@HOME

The Examiner rejected dependent Claims 4 and 7 under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladere*, *Eller*, and *Barber* (Office Action, ¶11); or, in the alternative, over (B) LAMBERT, ROTHBLATT, *Foladere*, *Rakavy*, EXCITE@HOME, *Eller*, and *Barber* (Office Action, ¶21). At least because Claims 4 and 7 depend from independent Claim 1, which is patentable over the cited prior art, Claims 4 and 7 are also patentable over the cited prior art. Withdrawal of the rejection is respectfully requested.

VI. Rejection of Claim 2 under §103 as obvious over either

(A) LAMBERT, ROTHBLATT, *Foladere*, and *Yuhn* or

(B) LAMBERT, ROTHBLATT, *Foladere*, *Yuhn*, *Rakavy*, *Eller* and EXCITE@HOME

The Examiner rejected dependent Claim 2 under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladere*, and *Yuhn* (Office Action, ¶12); and, in the alternative, over (B) LAMBERT, ROTHBLATT, *Rakavy*, EXCITE@HOME, *Eller*, and *Yuhn* (Office Action, ¶18). At least because Claim 2 depends from independent Claim 1, which is patentable over the cited

prior art, Claim 2 is also patentable over the cited prior art. Withdrawal of the rejection is respectfully requested.

VII. Rejection of Claim 3 under §103 as obvious over either

(A) LAMBERT, ROTHBLATT, Foladare, Yuhn, and MOTOROLA or

(B) LAMBERT, ROTHBLATT, Foladare, Yuhn, MOTOROLA, Rakavy, Eller and EXCITE@HOME

The Examiner rejected dependent Claim 3 under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladare, Yuhn*, and MOTOROLA (Office Action, ¶13); or, in the alternative, over (B) LAMBERT, ROTHBLATT, *Foladare, Yuhn*, MOTOROLA, *Rakavy*, EXCITE@HOME, and *Eller* (Office Action, ¶19). At least because Claim 3 depends from independent Claim 1, which is patentable over the cited prior art, Claim 3 is also patentable over the cited prior art. Withdrawal of the rejection is respectfully requested.

VIII. Rejection of Claim 22 under §103 as obvious over either

(A) LAMBERT, ROTHBLATT, Foladare, Yuhn, and Sachs or

(B) LAMBERT, ROTHBLATT, Foladare, Yuhn, Sachs, Rakavy, and Eller

The Examiner rejected dependent Claim 22 under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladare, Yuhn*, and *Sachs* (Office Action, ¶14); or, in the alternative, over (B) LAMBERT, ROTHBLATT, *Foladare, Yuhn, Rakavy, Eller*, and *Sachs* (Office Action, ¶20). At least because Claim 22 depends from independent Claim 1, which is patentable over the cited prior art, Claim 22 is also patentable over the cited prior art. Withdrawal of the rejection is respectfully requested.

IX. Rejection of Claim 23 under §103 as obvious over either

(A) LAMBERT, ROTHBLATT, Foladare, and ADWEEK or

(B) LAMBERT, ROTHBLATT, Foladare, ADWEEK, Rakavy, EXCITE@HOME, and Eller

The Examiner rejected dependent Claim 23 under 35 U.S.C. §103(a) as being unpatentable over (A) LAMBERT, ROTHBLATT, *Foladare*, and ADWEEK (Office Action, ¶15); or, in the alternative, over (B) LAMBERT, ROTHBLATT, *Foladare*, ADWEEK, *Rakavy*, EXCITE@HOME, and *Eller* (Office Action, ¶22). At least because Claim 23 depends from independent Claim 1, which is

patentable over the cited prior art, Claim 23 is also patentable over the cited prior art. Withdrawal of the rejection is respectfully requested.

Newly added Claim 24

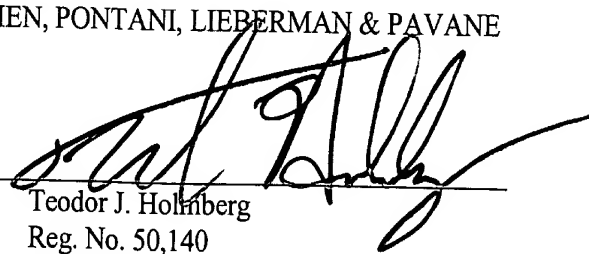
Independent Claim 24 was added in the current amendment. Claim 24 contains no new matter: Claim 24 contains material based at least on the text from page 8, line 2, to page 13, line 10 of the original specification, as well as originally filed FIGS. 1-3. Claim 24 recites "an electronic "book-of-the-month" subscription service" where a user who first subscribes to the service "by interacting with a subscription service on the Internet" receives offers to download digitally formatted texts "at predetermined time intervals and without user action", where each offer is accompanied by a portion of the digitally formatted electronic text being offered, where the user can access a preview portion of the at least a portion of the digitally formatted electronic text using the cellular telephone, and where the offer to download the digitally formatted electronic text is sent to the user if the digitally formatted electronic text corresponds to user-specific information provided by the user and stored at the subscription server. At least because the combination of the cited prior art neither teaches nor suggests this combination of limitations, newly added independent Claim 24 is patentable over the cited prior art. The allowance of newly added Claim 24 is respectfully requested.

At least for the foregoing reasons, allowance of all pending claims is respectfully requested.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By


Teodor J. Holmberg
Reg. No. 50,140
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: December 29, 2003